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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,461	01/22/2002	Ulrich Windmoller	TPP 31434	6981

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/051,461

Applicant(s)

WINDMOLLER ET AL.

Examiner

Sam Chuan C. Yao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 23 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 22-23 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure fails to provide sufficient support to newly added limitations of "*a non-electrically conducting decorative paper*" and "*said decorative layer (12) being devoid of electrically conducting particles*". For this reason, this engenders a New Matter situation.

NOTE: "*Any negative limitation or exclusionary proviso must have basis in the original disclosure. ... The mere absence of a positive recitation is not basis for an exclusion.*" (emphasis added; MPEP 2173.05(i)).

Note further that, on page 5 of Counsel's response, it states that a "*decorative paper is made of cellulose*" and cited a paragraph bridging pages 1-2. It should be noted, however, the cellulose material disclosed in this paragraph is referring to a transparent overlay cellulose layer and NOT a decorative paper. Even for the sake of argument that, a decorative paper is made of cellulose material, the

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original disclosure as a whole fails to reasonably convey to one in the art that at the time of filing, Applicant possesses the newly claimed subject matter of precluding conducting particles in a decorative paper.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable the Admitted Prior Art (APA; a preamble of a Jepson-type claim) in view of Perrin et al (US 5,677,039).

The APA, drawn to making a floor plank, substantially discloses the floor plank recited in claim 1 (see a preamble of a Jepson-type claim). The APA does not teach particles of an electrically conducting material are applied to the back surface of a decorative paper to make an electrically conductive floor plank. However, it would have been obvious in the art to form a floor plank, where particles of an electrically conducting material are applied to at least a back surface of a decorative paper to make an electrically conductive floor plank, because Perrin et al teaches applying electrically conductive particles onto "at least one face of" a decorative paper sheet on a laminate in order to provide an antistatic characteristic to a resultant laminate (abstract; col. 1 lines 3-8; col. 4 lines 11-53; col. 5 lines 1-13; claim 1).

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5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable the first Admitted Prior Art (1<sup>st</sup> APA; a preamble of a Jepson-type claim) in view of a second Admitted Prior Art (2<sup>nd</sup> APA), and optionally further in view of Dong et al (US 2002/0136862) and Hellmann et al (US 4,906,497).

The 1<sup>st</sup> APA, drawn to making a floor plank, substantially discloses the floor plank recited in claim 1 (see a preamble of a Jepson-type claim). The 1<sup>st</sup> APA does not teach particles of an electrically conducting material are applied to the back of a decorative paper to make an electrically conductive floor plank. However, it would have been obvious in the art to form a floor plank, where particles of an electrically conducting material are applied to the back of a decorative paper to make an electrically conductive floor plank, because, it is a common practice in the art to apply "*sheets of graphite-impregnated kraft paper behind a decorative layer*" as exemplified in the teachings of a 2<sup>nd</sup> APA. Note: claim 1 as presently recited does not preclude an application of an adhesive to bond a decorative paper and underlayers of graphite-impregnated kraft paper. In any event, it would have been obvious in the art to directly bond (i.e. adhesive free) sheets of graphite-impregnated kraft paper behind a decorative layer as such is old in the art. See for example, the teachings of Cannady, Jr. set forth in numbered paragraph 9 below.

**Alternatively**, the 1<sup>st</sup> APA is silent on the type of adhesive which is used for bonding a decorative sheet and underlayers of graphite-impregnated kraft paper. However, it would have been obvious in the art to use a microwave

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activated hot-melt adhesive containing metallic particles as well as anti-static agents, because: a) it is old in the art to use hot-melting adhesive for bonding decorative and base layers to form a decorative laminated panel as exemplified in the teaching: Dong et al (numbered paragraphs: 0019, 0103', 01 19-0122); and, b) Hellmann et al discloses incorporating metallic particles in forming a microwave activated hot-melting adhesive in order to enhance the heating rate of the adhesive and further suggests incorporating antistatic agents to the adhesive, wherein the adhesive is suitable for making flooring articles (abstract; col. 1 lines 1-1 1 ; col. 4 line 10 to col. 5 line 10).

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 4 or 5 as applied to claim 1 above, and further in view of JP 4-145992 A.

None of the references set forth in numbered paragraph 4 or 5 teaches using iron powder for a conductive material. However, it would have been obvious in the art to use iron powder in forming a paper layer taught by EP '237, because iron powder is a well known material in the art to have "*an excellent electric conductivity*" and it is also known to provide an antistatic function as exemplified in the teachings of JP '992 (abstract).

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 4 or 5 as applied to claim 1 above, and further in view of Mehta et al (US 6,879,781) and Cannady, Jr. (US 4,540,624).

It would have been obvious in the art to provide a backing sheet onto an

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underside surface of core sheets, because a) Mehta et al discloses providing a backing sheet to a core sheet in order to prevent a resultant decorative laminate from warping (col. 2 lines 1-51; figure 1). Moreover, it would have been obvious in the art to provide conductive particles to a backing sheet in a modified laminate of the APA, since it is old in the art to provide conductive particles to various layers of an antistatic laminate as exemplified in the teachings of Cannady, Jr.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 22 and 30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

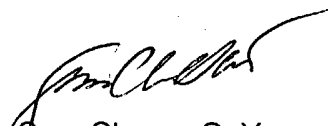
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sam Chuan C. Yao  
Primary Examiner  
Art Unit 1733

Scy  
10-14-04